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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/603,222 06/26/00 EPSTEIN

M EMR-100-A-1

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QM12/1109

EXAMINER

MOHANDESI, J

ART UNIT

PAPER NUMBER

3728
DATE MAILED:

11/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/096,946

Applicant(s)
Epstein

Examiner
Jila Mohandesi

Group Art Unit
3728



☒ Responsive to communication(s) filed on Nov 1, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 7, and 8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 7, and 8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 7-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,098,319. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is nothing unobvious about providing a single disc versus a plurality of discs in a kit to make the kit cheaper.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

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ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kantro (5,170,572) in view of Cherniak (3,099,267) alone, or further in view of Shaw (1,958,097), Smith (5,345,701) and Marc (5,068,983). Kantro '572 teaches substantially all the limitations of the claims. For example a substantially circular balancing disc/cushion **20** is preferably made from a polymeric foam material of high density to provide the necessary support at the gait points. The top surface and bottom surface of disc/cushion **20** can also be angularly tapered through its thickness from its forward edge rearward with respect to each other as described at column 4, lines 14-49 and column 5, lines 37-41. Note that heel cushion/disc **19** is **tapered** at about 5 degrees. It is submitted the only reasonable conclusion (by comparison of column 4, line 32 to line 46) is that cushion **20** is also exactly **tapered** as described for cushion/disc **19**. Note that while Kantro '572 has chosen to use the term "cushions" for elements **19**, **20** and **21**, a careful review of the entire disclosure reveals that the "high density foam material" *must necessarily be sufficiently rigid* to alter the biomechanical balance and weight distribution by providing support to specific points. The structure and function, therefore, are submitted to be the same as applicant's, notwithstanding the use of the term "cushion". If for purposes of argument any doubt should subsequently be raised concerning whether the language in Kantro '572 "Polymeric foam material of a high density to provide the necessary support at the gait" at column 4, line 14-16 means that the discs will inherently will be substantially rigid. Cherniak '267 is cited to resolve that doubt. Cherniak '267 teaches that circular foot balancing devices (**50**, **52**, **54**) "may be rigid or yieldable", see column 2, lines 1-2. Therefore, it would have

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been obvious to one having ordinary skill in the art and in view of Cherniak '267 to make the circular balancing disc/cushion **20** of Kantro '572 more rigid or sufficiently rigid to ensure better support and weight distribution. The Shaw '097, Smith '701 and Marc '983 references are cited if for purposes of argument any doubt should subsequently be raised concerning the language in Kantro '572 "tapered along an axis directed at an angle" at column 4, line 46. Shaw '097 teaches an orthotic insole having angularly inclined wedge members having a transverse thickened portion **tapered** at about 3 degrees from one edge of the insole to a point beyond its longitudinal center line and restricted approximately to the portion of the insole that underlies the metatarsal heads of a superimposed foot, and another transverse thickened portion at the heel **tapered** from the opposite edge of the insole to a point beyond said center line and spaced a substantial distance from the heel end. Marc '983 teaches an insole having about a 2 degree **tapered** resilient base piece **20** adapted to conform to the foot and having a base surface and, a top surface inclined with respect to each other and a cupped periphery for accommodating the heel and extending to the arch area. Smith '701 teaches an orthotic device **20**, including a foot sole portion **30** together with a pair of correcting wedges **24** and **26 tapered** at about 4 degrees. The wedges **24** and **26** can be seen (Fig. **2b**) to change the angle of the bottom of the foot sole portion **30** relative to the ground, thus bringing the ground up to meet the soles of the patients foot. It will be appreciated that the wedges **24** and **26** can be formed at any angle, depending on the patients needs. These references both individually and collectively are representative of corrective wedge members having upper and lower surfaces angularly inclined by a small angle greater than zero (in the range of about 2 to 5 degrees) which are

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used with insoles and orthotics to enhance or correct biomechanical balance and weight distribution.

Therefore, it would have been obvious to one having ordinary skill in the art and especially in view of each of Shaw '097, Marc '983 and Smith '701 to form the circular cushion member of ~~Cherniak~~ ^{Kantro '572} '267 with a top surface and a bottom surface angularly inclined by a small angle greater than zero, such as in the 2-6 degree range, to further enhance or correct the biomechanical balance and weight distribution. With respect to the claims, the Shaw '097 (3 degrees), Marc '983 (2 degrees) and Smith '701 (4 degrees) references establish that the specific angle is a design choice depending on the shape and disposition with respect to the balancing foot disc/device and the routine optimization expected by one of ordinary skill in the art dependent upon the individuals biomechanical features and the desired correction and it would have been obvious over Shaw '097, Marc '983 and Smith '701 to select the angle between the upper and lower planar surfaces of the balancing device of Kantro '572 to be whatever angle is appropriate, including between about 2 to about 6 degrees.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited on PTO-892 enclosed herewith.

6. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without

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contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ebony Smith at (703)305-3570.

For applicant's convenience, the Group Technological Center FAX number is (703) 305-3579. Please identify Examiner _____ of Art Unit _____ at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015.



Paul T. Sewell
Supervisory Patent Examiner
Group 3700

JMM

November 2, 2000